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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,717	10/22/2003	Jonathan S. Stinson	10527-501001	9775
26161	7590	02/23/2005	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			MORILLO, JANEL COMBS	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/690,717

Applicant(s)

STINSON, JONATHAN S.

Examiner

Janelle Combs-Morillo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-36,41 and 44-59 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-26,41 and 44-59 is/are rejected.
- 7) ☒ Claim(s) 3, 27-36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Because the original election of species covered all of the claims, not just claim 27, and claims drawn to the Pt species are held to be rejected in view of the prior art (see below), additional species have not been examined.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4-9, 13-21, 41, 44-47, 50-59 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 61-133339A (JP'339).

JP'339 teaches a Pt alloy to be for ornamental products, wherein said alloy comprises (in weight%): 84-96% Pt, 1-10% Cr (abstract). Example 2 of JP'339 is drawn to an alloy with 90%Pt, 7% Cr, which falls within the presently claimed alloying ranges (instant alloy claims 1, 4-9, 13, 41, 44-47, 50-51, 55). Said alloy claims also mention various elements not mentioned by the prior art of JP'339, however the instant claims do not mention a minimum amount of said elements (i.e. "less than about 22 weight percent of chromium", etc.). The instant claims mention

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Fe must be present, however a minimum range of Fe is not specified. However, Fe is held to be in the alloy taught by JP'339 at least on the order of ppm as an impurity.

JP'339 does not mention said alloy is used for a medical device (indep. cl. 1, 37). The phrase "medical device", is held to define merely an intended use for the alloy composition (said limitation does not denote a particular specific mechanical configuration). Because the prior art teaches an alloy good workability and mechanical strength (abstract), said alloy appears to be inherently capable of performing said intended use as recited in the preamble, See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997), MPEP 2111.02.

Because JP'339 teaches an example within the presently claimed alloying ranges, it is held that the Pt alloy taught by JP'339 anticipates the presently claimed invention.

Concerning claims 14-17, and 52-55, which mention a martensitic structure, because JP'339 teaches a substantially overlapping alloy composition, then substantially the same phase is inherently expected to occur.

Concerning claims 18-21 and 56-59, which mention properties such as pitting resistance, hardness, TS, and density, as stated above, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are inherently present. See MPEP 2112.01.

4. Claims 10-12, 48, and 49 are rejected under 35 U.S.C. 102(b) or (e) as anticipated by JP'339. JP'339 is discussed in the paragraph above.

The prior art of JP'339 does not mention the presence of Ni (cl. 10, 11, 48, 49) or Cu, Mn, Ni, P, Si, N, S, and C (cl. 12). However, a minimum range of said elements is not specified.

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A range of said elements, at least on the order of ppm as an impurity, is held to be inherent in the alloy taught by JP'339.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over or JP'339 in view of Martyniuk et al (US 5,524,338).

The prior art of JP'339 does not teach a medical device made out of said Pt based alloy, wherein said medical device is a surgical instrument or cutting element of a balloon catheter, substantially as presently claimed.

Concerning claims 22, 24, and 25, Martyniuk teaches that medical needles (#42) or parts of microelectrodes (#74, #70) column 7 lines 6, 22-24) can be made out of corrosion resistant Pt-Ir (column 5 lines 46-47). It would have been obvious to one of ordinary skill in the art to form the high Pt content alloys taught by the prior art of JP'339, into a surgical needle or parts of microelectrodes used as medical devices (as taught by Martyniuk), because of the biocompatibility of Pt alloys taught by Martyniuk.

Additionally, concerning claims 23 and 26, though Martyniuk does not mention forming a prosthesis or cutting element, it would have been obvious to one of ordinary skill in the art to form the high Pt alloys taught by the prior art of JP'339, into a variety of medical instruments or

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implants, including a prosthesis or cutting element, because of the biocompatibility of Pt alloys taught by Martyniuk.

***Allowable Subject Matter***

7. Claims 3, 34, and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Concerning claim 3, the prior art does not teach or suggest a Pt alloy complete with the presently claimed ranges of Cr and Mo.

9. Concerning claims 34 and 36 the prior art does not teach or suggest a medical device comprising an alloy with  $\geq 50\text{wt}\%$  Pt and a stainless steel.

10. Generic claims 27-33 and 35 are objected to as being drawn in part to nonelected species, but would be allowable if limited to the elected species.

***Response to Amendment/Arguments***

11. In the response filed on November 26, 2004, applicant amended claims 1, 20, and 41, and submitted various arguments traversing the rejections of record. The examiner agrees that applicant has overcome the rejections over Aoyama, Cook, and JP'948. However, the rejections over JP'339 have not been overcome. Applicant's argument that the present invention is allowable over the prior art of record because there is no motivation to combine JP'339 and Martyniuk has not been found persuasive. As stated above, it would have been obvious to one of ordinary skill in the art to form the high Pt content alloys taught by the prior art of JP'339, into a

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surgical needle or parts of microelectrodes used as medical devices (as taught by Martyniuk), because of the biocompatibility of Pt alloys taught by Martyniuk.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JCM

February 16, 2005

  
GEORGE WYSZOMIERSKI  
PRIMARY EXAMINER